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OFFICE OF PETITIONS

In re Application of	:
Rosen et al.	:
Application No. 09/937,192	:
International Filing Date: April 7, 2000	: Decision on Petition for
U.S. Patent No. 7,238,682	: Patent Term Extension
For: Methods and Compositions for	:
Degradation and/or Inhibition of HER-Family	:
Tyrosine Kinases	:

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Request for Reconsideration of: Petition to the Director Under 1.181," received on June 12, 2007. The petition is being treated as a petition for corrected patent term extension under 37 CFR 1.701. See 35 U.S.C. § 154(b)¹ and 37 CFR § 1.701.

The petition under 37 CFR 1.182 or 1.183 is denied.

Background

Petitioner filed a petition as a "Petition To the Director Under 37 CFR 1.181" for review of the patent term extension on January 10, 2007, for an extension of the patent term. Petitioner requested a patent term extension of 1,054 days, 602 days or at the very least 338 days due to delays in the Office during which the application was under appeal. On May 25, 2007, the petition was dismissed and the patent term extension was 0 days.

Petitioner contends that the original petition was dismissed in error, as the petition was dismissed because the Legal Advisor could not find a decision of Appellate Review in favor of Applicant, as the Legal Advisor concluded that "while the Examiner was reversed on the 112 rejection, the Examiner

¹ 35 U.S.C. § 154 was amended by the "American Inventors Protection Act of 1999," which was enacted on November 29, 1999 as part of Public Law 106-113 (Consolidated Appropriations Act for Fiscal Year 2000). Since this amendment is effective May 29, 2000 and applies to applications filed on or after that date, the prior patent term adjustment provisions of 35 U.S.C. § 154 continue to apply to the above-identified application.

was affirmed on the provisional obvious double patenting rejections for all the claims. Since the Examiner has not been reversed on at least one claim for all grounds, there is not a final decision in favor of applicants”.

Petitioner asserts that the provisional double patenting rejection was never an issue on appeal, as the only grounds of rejections on appeal in this case were the 35 U.S.C. 112 rejections. Petitioner asserts that the examiner acknowledged this in the Examiner’s Answer concluding that the “appellants grounds of rejection to be reviewed on appeal is correct, however then the Examiner repeated the obvious double patenting rejection in the Examiner’s Answer.

Petitioner asserts that even if the provisional obvious double patenting rejection were an issue in the appeal, which it was not, that Applicant’s can find nowhere where it states that the Examiner has to be reversed “on at least one claim for all grounds” to find a decision in favor of Applicants as asserted in the Decision on Petition.

Petitioner argues that the BPAI reversed all of the Examiner’s 112 rejections and the case proceeded straight to allowance and no terminal disclaimer was filed, thus the only determination adverse to patentability was reversed. Petitioner asserts that the provisional rejection and could not mature to an actual basis for rejection.

Petitioner contends that the instant application is entitled to 1054 days, 602 days or at the very least 338 days of patent term extension as compensation for the delays due prosecution of the application. Petitioner contends that since the Examiner was reversed on the § 112 first and second paragraph rejections that there was a final decision in favor of applicant.

Applicable Statutes and Regulation

35 U.S.C. 154. Contents and term of patent (in effect on June 8, 1995)

(b) TERM EXTENSION.-

(1) INTERFERENCE DELAY OR SECRECY ORDERS.-If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

(2) EXTENSION FOR APPELLATE REVIEW.-If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

35 U.S.C. § 154(b)(as amended by the “Uruguay Round Agreements Act,” enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.

35 U.S.C. § 154(b)(as amended by the “American Inventors Protection Act of 1999,” enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these

administrative delays and others in applications filed on or after May 29, 2000. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

37 CFR 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

- (1) interference proceedings under 35 U.S.C. 135(a); and/or
- (2) the application being placed under a secrecy order under 35 U.S.C. 181; and/or
- (3) appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3), and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) with respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) the number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) the number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) the number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) the member of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) the number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal Court in an appeal under 35 U.S.C. 145.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and

(2) any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

(e) The provisions of this section apply only to original patents, except for design patents, issued on applications filed on or after June 8, 1995, and before May 29, 2000.

Opinion

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.

35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000.

In order to implement 35 U.S.C. 154(b) (in effect between June 8, 1995 and May 28, 2000), the Office promulgated 37 CFR 1.701(a)(3) and 37 CFR 1.701(c)(3), which, consistent with the statute, requires a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal Court in an appeal under 35 U.S.C. 145 to be eligible for patent term extension.

The above-identified application was filed on April 7, 2000. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was a successful appellate review, interference or a secrecy order delays as set forth in the statute.

Petitioner's argument that patent term extension should be awarded to the above-identified application, because after the decision by the BPAI, the application was allowed without a terminal disclaimer being filed is not persuasive. While the examiner was reversed on the § 112 rejections, the Examiner was affirmed on the provisional obvious double patenting rejections for all the claims. Since the Examiner has not been reversed on at least one claim for all the grounds, there is not a final decision in favor of Applicants. As noted on page 8 of the "Decision on Appeal" by the BPAI, which was mailed on August 28, 2006, the Examiner was "**Affirmed**," there was not a final decision in favor of Applicants.

Petitioner's argument that there is no support for the assertion that the Examiner has to be reversed "on at least one claim for all grounds" to find a decision in favor of Applicants is not persuasive. Both 37 CFR 1.701(a)(3) and 37 CFR 1.701(c)(3), which, consistent with the statute, requires a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal

Court in an appeal under 35 U.S.C. 145 to be eligible for patent term extension. According to Changes to Implement 20-Year Patent Term and Provisional Applications, 60 FR 20195, 20219, (April 25, 1995) Comment 137 and Response, "[e]xtension of patent term under § 1.701(a) (3) is applicable if all the rejections on any one claim are ultimately reversed."

Petitioner's argument that the obvious double patenting rejection was not an issue, as the Examiner acknowledged that the Appellants grounds of rejection in the Brief was correct, which omitted the obvious double patenting rejection is not persuasive. In the Office Action from which the Appeal was taken, the Examiner made an obvious double patenting rejection and then he repeated the obvious double patenting rejection in the Examiner's Answer. Petitioner did not note or argue the obvious double patenting rejection in Applicants' Reply Brief.

The application was not issued due to an adverse determination of patentability by the BPAI, was not delayed due to an interference proceeding, nor was it subject to a secrecy order, as a result, this application is not eligible for the extension under 35 U.S.C. 154 in effect on June 8, 1995 and 37 CFR 1.701. While a Notice of Appeal and an Appeal Brief were filed in the application, the application was not allowed pursuant to an adverse determination of patentability by the BPAI.

The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154. Since, the application was not issued due to an adverse determination of patentability by the BPAI, the Office is without authority to grant the application patent term extension under 35 U.S.C. 154(b)(2) and 37 CFR 1.701.

The delay in the allowance and issuance is regrettable, but the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b).

Decision

The prior decision which refused to grant a petition under 35 U.S.C. 154(b) and 37 CFR 1.701 for patent term extension for the delayed issuance of the patent for the above-identified patent application has been reconsidered. For the reasons stated herein, and in the previous decision, however, a patent term extension in this case cannot be granted under 35 U.S.C. § 154(b) in effect on June 8, 1995 and 37 CFR §§ 1.182 and 1.701. Therefore, the petition is **denied**.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(a)(7). Accordingly, as authorized, the required \$400 fee for the petition has been charged to petitioner's Deposit Account.

This decision may be viewed as a final agency action. See MPEP § MPEP 1002.02(b):

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



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